

AF *zhw***AMENDMENT TRANSMITTAL****PATENT**

Application No.: 09/873,067
Filing Date: 12/26/01
First Named Inventor: Tobin, et al.
Examiner's Name: T. Zhou
Art Unit: 2173
Attorney Docket No.: 80398.P596

- ☐ An Amendment After Final Action (37 CFR 1.116) is attached and applicant(s) request expedited action.
- ☒ Charge any fee not covered by any check submitted to Deposit Account No. 02-2666.
- ☒ Applicant(s) hereby request and authorize the U.S. Patent and Trademark Office to (1) treat any concurrent or future reply that requires a petition for extension of time as incorporating a petition for extension of time for the appropriate length of time and (2) charge all required fees, including extension of time fees and fees under 37 CFR 1.16 and 1.17, for any concurrent or future reply to Deposit Account No. 02-2666.
- ☐ Applicant(s) claim small entity status (37 CFR 1.27).

ATTACHMENTS

- ☐ Preliminary Amendment
- ☐ Amendment/Response with respect to Office Action
- ☐ Amendment/Response After Final Action (37 CFR 1.116) (reminder: consider filing a Notice of Appeal)
- ☐ Notice of Appeal
- ☐ RCE (Request for Continued Examination)
- ☐ Supplemental Declaration
- ☐ Terminal Disclaimer (reminder: if executed by an attorney, the attorney must be properly of record)
- ☐ Information Disclosure Statement (IDS)
- ☐ Copies of IDS citations
- ☐ Petition for Extension of Time
- ☐ Fee Transmittal Document (that includes a fee calculation based on the type and number of claims)
- ☐ Cross-Reference to Related Application(s)
- ☐ Certified Copy of Priority Document
- ☒ Other: Response to Notice of Non-Compliant Appeal Brief (2 pgs.)
- ☒ Other: Appeal brief and Appendix (16 pgs.)
- ☐ Check(s)
- ☒ Postcard (Return Receipt)

SUBMITTED BY:

BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP

TYPED OR PRINTED NAME: Eric S. ReplogleSIGNATURE: *Eric S. Replogle*REG. NO.: 52,161DATE: Dec. 10, 2007ADDRESS: 1279 Oakmead ParkwaySunnyvale, CA 94085-040TELEPHONE NO.: (408) 720-8300**CERTIFICATE OF MAILING BY FIRST CLASS MAIL (if applicable)**

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria Virginia 22313-1450 on December 10, 2007

Date of Deposit

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December 10, 2007

Date

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Atty Docket No. 80398.P596

Patent

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:) Examiner:	T. Zhou
)	
Tobin, et al.) Art Unit:	2173
)	
Serial No. 09/873,067) Confirmation No:	2986
)	
Filed: December 26, 2001)	
)	
For: PERSISTENT NAVIGATION)	
ASSISTANCE)	
)	

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RESPONSE TO NOTICE OF NON-COMPLIANT APPEAL BRIEF

This is a response to the Notice of Non-Compliant Amendment mailed November 14, 2007. The Examiner objected to the appeal brief because the appeal brief does not contain a separate concise explanation of the claimed subject matter for independent claims 17 and 35. In response, Appellant respectfully submits that the attached appeal brief, as amended, overcomes these objections. Accordingly, Appellant respectfully requests the withdrawal of the objection.

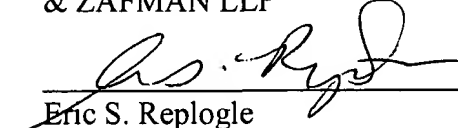
REMARKS

Applicants hereby submit an amended Appeal Brief Under 37 C.F.R. §41.37.
Applicant believes there is no fee due. If there are costs involved, please charge them to
Deposit Account No. 02-2666.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR
& ZAFMAN LLP

Dated: 12/10/07


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Atty Docket No. 80398.P596

Patent

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:)	Examiner:	T. Zhou
)		
Tobin et al.)	Art Unit:	2173
)		
Application No. 09/873,067)	Confirm. No:	2986
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Filed: June 6, 2001)		
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For: PERSISTENT NAVIGATION)		
ASSISTANCE)		
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Alexandria, VA 22313-1450

APPEAL BRIEF UNDER 37 C.F.R. § 41.37

This is an appeal to the Board of Patent Appeals and Interferences from the decision of the Examiner of Group 2173, mailed June 23, 2006, in which claims 17-40 in the above-identified application were rejected in a final action. This Appeal Brief is hereby submitted pursuant to 37 C.F.R. § 41.37(a).

I. REAL PARTY IN INTEREST

The real parties in interest are the co-assignees of the full interest in the invention: Sony Electronics, Inc., Park Ridge, New Jersey, and Sony Corporation, Tokyo, Japan.

II. RELATED APPEALS AND INTERFERENCES

To the best of Appellant's knowledge, there are no appeals or interferences related to the present appeal that will directly affect, be directly affected by, or have a bearing on the Board's decision in the instant appeal.

III. STATUS OF THE CLAIMS

Claims 17-40 are pending in the application and were finally rejected in an Office Action mailed June 23, 2006. Claims 1-16 are cancelled. Claims 17-40 are the subject of this appeal. A copy of Claims 17-40 as they stand on appeal are set forth in Appendix A.

IV. STATUS OF AMENDMENTS

No amendments to the claims have been made after receipt of the Final Office Action.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Independent method claim 17 claims identifying a particular product displayed in a web page using a device that displays a web page to the user [Specification, Figure 5, block 504, paragraphs 36 and 38]. Furthermore, independent claim 17 claims determining with the device whether an entry corresponding to the particular product in a supplemental information database [Specification, Figure 5, block 508, paragraph 38]. Independent claim 17 further claims that the database is separate from the displayed web pages and correlates supplemental information to differing products [Specification, paragraph 36]. In addition, claim 17 claims that the displayed web pages are ordinarily devoid of the supplemental information [Specification, paragraph 36]. Independent claim 17 claims displaying the supplemental information correlated with the particular product along with and separate from the web page if the database contains an entry for the particular product [Specification, Figure 5, block 512, paragraph 39].

Independent computer readable media claim 35 claims identifying a particular product displayed in a web page using a device that displays a web page to the user [Specification, Figure 5, block 504, paragraphs 36 and 38]. Furthermore, independent claim 35 claims determining with the device whether an entry corresponding to the particular product in a supplemental information database [Specification, Figure 5, block 508, paragraph 38]. Independent claim 35 further claims that the database is separate from the displayed web pages and correlates supplemental information to differing products [Specification, paragraph 36]. In addition, claim 35 claims that the displayed

web pages are ordinarily devoid of the supplemental information [Specification, paragraph 36]. Independent claim 35 claims displaying the supplemental information correlated with the particular product along with and separate from the web page if the database contains an entry for the particular product [Specification, Figure 5, block 512, paragraph 39].

Independent apparatus claim 23 claims a link assessment module that identifies a particular product display in a web page using a device that displays the web page [Specification, Figure 3, block 314, paragraph 36]. Furthermore, independent claim 23 claims that the link assessment module determines with the device whether an entry corresponding to the particular product in a supplemental information database [Specification, paragraph 38]. Independent claim 23 further claims that the database is separate from the displayed web pages and correlates supplemental information to differing products [Specification, paragraph 36]. In addition, independent claim 23 claims that the displayed web pages are ordinarily devoid of the supplemental information [Specification, paragraph 36]. Independent claim 23 claims a supplemental information display module that displays the supplemental information correlated with the particular product along with and separate from the web page if the database contains an entry for the particular product [Specification, Figure 3, block 316, paragraph 39].

Claims 29-34 are claims under 35 U.S.C. § 112, 6th paragraph. Independent apparatus claim 29 claims means for identifying a particular product display in a web page using a device that displays the web page [Specification, Figure 3, block 314, paragraph 36]. The corresponding structure for the means for identifying is shown in Figure 3, block 314. Furthermore, independent claim 29 claims that the means for identifying determines with the device whether an entry corresponding to the particular product in a supplemental information database [Specification, Figure 3, block 314, paragraph 38]. Independent claim 29 further claims that the database is separate from the displayed web pages and correlates supplemental information to differing products [Specification, paragraph 36]. Independent claim 29 claims that the displayed web pages are ordinarily devoid of the supplemental information [Specification, paragraph 36]. In addition, independent claim 29 claims means for displaying the supplemental information correlated with the particular product along with and separate from the web page if the

database contains an entry for the particular product [Specification, Figure 3, block 316, paragraph 39]. The corresponding structure for the means for displaying is shown in Figure 3, block 316.

Dependent claim 33 depends from independent claim 29 and claims a means for detecting an event related to the particular product, where the event prompts the display of the supplemental information for the particular product. The corresponding structure for the means for detecting is shown in Figure 3, block 312.

Dependent claim 19 depends from independent claim 17 and claims a second web page that correlates to a purchasable item and that the supplemental information includes a consumer incentive relating to the purchasable item and the user [Specification, paragraphs 39-40]. Furthermore, dependent claim 19 claims obtaining the consumer incentive from the database with the consumer incentive not being ordinarily evident from the first web page [Specification, paragraphs 40-41].

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

I. Claims 23-28 stand rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory matter.

II. Claims 17-18, 21-24, 27-30, 33-36, and 39-40 stand rejected under 35 U.S.C. § 103(a) as being obvious over Jakobson, U.S. Patent No. 6,697,838, in view of Revashetti, U.S. Patent No. 6,230,199.

III. Claims 19-20, 25-26, 31-32, and 37-38 stand rejected under 35 U.S.C. § 103(a) as being obvious over Jakobson in view of Revashetti and Harris, US Patent 6,014,635.

VII. ARGUMENTS

I. Claims 23-28 are Patentable under 35 U.S.C. § 101 because the claimed invention is directed to statutory subject matter.

The Examiner asserts that independent apparatus claim 23 is not tangible because the claim recites software elements. Appellant respectfully disagrees. Independent claim 23 claims an apparatus comprised of several modules. Appellant's specification supports

that the modules can be hardware (Specification, paragraph 0032). Therefore, Appellant respectfully submits that claims 23-28 are directed to statutory subject matter and respectfully requests the withdrawal of the rejection.

II. Claims 17-18, 21-24, 27-30, 33-36, and 39-40 are Patentable under 35 U.S.C. § 103(a) over Jakobson in view of Revashetti because the combination does not teach or suggest all elements in the claims.

Claims 17-18, 21-24, 27-30, 33-36, and 39-40 stand or fall together. Independent claim 17 is the representative claim.

Jakobson allows a user to create and display notes specific to a web page. The notes are stored locally on a user's computer and are displayed in a separate frame from the web page.

Revashetti discloses a system that inventories the software and hardware components of a user's computer. Based on that inventory, the system markets to the user products associated with the user's computer. Revashetti does not disclose inventorying products associated with a displayed web page.

Appellant respectfully submits that the combination of Jakobson and Revashetti is improperly motivated and does not teach or suggest each and every element of claim 17.

The Examiner asserts that Jakobson and Revashetti can be combined by modifying the user notes taught by Jakobson to include the product advertisements taught by Revashetti. However, Jakobson specifically states that his invention is directed toward allowing a user to annotate a web page with the user's comments (Jakobson: col. 2, lines 19-22). There is nothing in Jakobson that suggests modifying a user's notes to include data created by someone else. Thus, modifying Jakobson's notes to include downloaded product advertisements would change the principal of operation of Jakobson. If the proposed modification would change the principle of operation of the prior art invention being modified, then the teachings of the reference are not sufficient to render the claim *prima facie* obvious. *In re Ratti*, 270 F.3d 810, 123 USPQ 349 (CCPA (1959)). Accordingly, the combination of Jakobson and Revashetti is improper.

Claim 17 recites correlating supplemental information particular to a user about a product in database identified in a web page on a device that displays the web page to the

user. The Examiner admits that Jakobson does not teach or suggest this claimed element and relies on Revashetti as disclosing it. However, because Revashetti discloses marketing products to the user based on software and hardware components of a user's computer, Revashetti does not teach or suggest inventorying products associated with a displayed web page. Thus, Revashetti cannot teach or suggest correlating supplemental information about a product in a database identified in a web page as claimed. Thus, neither Jakobson nor Revashetti disclose this claim element in claim 17 and the combination cannot be properly interpreted as doing so.

Accordingly, Appellant respectfully requests the withdrawal of the rejection of the claims 17-18, 21-24, 27-30, 33-36, and 39-40 under 35 U.S.C. § 103(a) over the combination of Jakobson and Revashetti.

III. Claims 19-20, 25-26, 31-32 and 37-38 are Patentable under 35 U.S.C. § 103(a) over Jakobson in view of Revashetti and Harris because the combination does not teach or suggest all elements in the claims.

Claims 19-20, 25-26, 31-32 and 37-38 stand or fall together. Dependent claim 19 is the representative claim.

Harris is directed towards providing a discount credit based transition network.

Appellant respectfully submits that the combination does not teach or suggest each and every limitation of Appellant's claim 19. Claim 19 depends from independent claim 17. Independent claim 17 recites correlating supplemental information particular to a user about a product. Because Harris is directed towards providing a discount credit based transition network, Harris cannot teach or suggest Appellant's claimed element of displaying on a web page, supplemental product information entries in database on a device that displays the web page to the user. Because Harris does not teach or suggest this claimed element that is missing in the Jakobson and Revashetti combination, the Jakobson, Revashetti and Harris combination cannot be properly interpreted as disclosing Appellant's invention as claimed in claim 19.

Accordingly, Appellant respectfully requests the withdrawal of the rejection of the claims 19-20, 25-26, 31-32 and 37-38 under 35 U.S.C. § 103(a) over the combination of Jakobson, Revashetti and Harris.

VIII. CONCLUSION

Appellant's claims 23-28 are patentable because the claimed invention is directed to statutory subject matter. Appellant's claims 17-18, 21-24, 27-30, 33-36, and 39-40 are patentable because the combination of Jakobson and Revashetti is improper and further does not teach or suggest all the limitations in the claims. Appellant's claims 19-20, 25-26, 31-32 and 37-38 are patentable because the combination of Jakobson, Revashetti and Harris does not teach or suggest all the limitations in the claims. Accordingly, Appellant respectfully requests the Board reverse the rejections of claims 1-2, 4-11, and 13-32 under 35 U.S.C. § 103(a), and direct the Examiner to enter a Notice of Allowance for claims 1-2, 4-11, and 13-32.

Fee for Filing a Brief in Support of Appeal

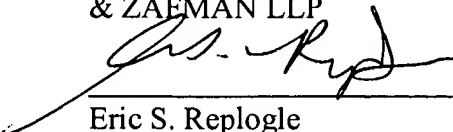
Enclosed is a check in the amount of \$500.00 to cover the fee for filing a brief in support of an appeal as required under 37 C.F.R. §§ 1.17(c) and 41.37(a).

Deposit Account Authorization

Authorization is hereby given to charge our Deposit Account No. 02-2666 for any charges that may be due. Furthermore, if an extension is required, then Appellant hereby requests such extension.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR
& ZAEMAN LLP



Eric S. Replogle
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Dated: 12/10, 2007

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CLAIMS APPENDIX

1-16. (Cancelled)

17. (Previously Presented) A method of displaying supplemental information particular to a user regarding displayed web pages for the user, the method comprising:

identifying a particular product displayed in a first web page using a device that displays the first web page to the user;

determining, with the device, whether an entry corresponding to the particular product displayed on the first web page is contained in a database on the device, wherein the database comprises supplemental information particular to a user and correlates the supplemental information to each of a plurality of products, and wherein the database is separate from the first web page and the first web page is ordinarily devoid of the supplemental information; and

displaying supplemental information correlated to the particular product along with and separate from the first web page if it is determined that the database contains an entry for the particular product.

18. (Previously presented) The method of claim 17, wherein the particular product is associated with a link to a second web page.

19. (Previously Presented) The method of claim 18, wherein the second web page correlates to a purchasable item, and the supplemental information includes a consumer incentive available to the user and relating to the purchasable item, the consumer

incentive being obtained from the database and not being ordinarily evident from the web page.

20. (Previously Presented) The method of claim 19, wherein the consumer incentive is a discount for purchasing the purchasable item from the web site using a particular credit card, the database includes an entry indicating that the user has the particular credit card, and the supplemental information indicates that the user will obtain the consumer incentive where the particular credit card is used to purchase the purchasable item.

21. (Previously Presented) The method of claim 17, further comprising:
detecting an event relating to the particular product, wherein the event prompts the display of supplemental information for the particular product.

22. (Previously Presented) The method of claim 21, wherein the event is a cursor rollover of the particular product, and the supplemental information is superimposed on the first web page in the vicinity of the display of the particular product.

23. (Previously Presented) An apparatus for displaying supplemental information particular to a user regarding displayed web pages for the user, the apparatus comprising:
a link assessment module, for identifying a particular product displayed in a first web page using a device that displays the first web page to the user and determining, with the device, whether an entry corresponding to the particular product displayed on the first web page is contained in a database on the device, wherein the database comprises

supplemental information particular to a user and correlates the supplemental information to each of a plurality of products, and wherein the database is separate from the first web page and the first web page is ordinarily devoid of the supplemental information; and

a supplemental information display module, in communication with the link assessment module, for displaying supplemental information correlated to the particular product along with and separate from the first web page if it is determined that the database contains an entry for the particular product.

24. (Previously Presented) The apparatus of claim 23, wherein the particular product is associated with a link to a second web page.

25. (Previously Presented) The apparatus of claim 24, wherein the second web page correlates to a purchasable item, and the supplemental information includes a consumer incentive available to the user and relating to the purchasable item, the consumer incentive being obtained from the database and not being ordinarily evident from the web page.

26. (Previously Presented) The apparatus of claim 25, wherein the consumer incentive is a discount for purchasing the purchasable item from the web site using a particular credit card, the database includes an entry indicating that the user has the particular credit card, and the supplemental information indicates that the user will obtain the consumer incentive where the particular credit card is used to purchase the purchasable item.

27. (Previously Presented) The apparatus of claim 23, further comprising:
an event detecting module, for detecting an event relating to the particular product, wherein the event prompts the display of supplemental information for the particular product.

28. (Previously Presented) The apparatus of claim 27, wherein the event is a cursor rollover of the particular product, and the supplemental information is superimposed on the first web page in the vicinity of the display of the particular product.

29. (Previously Presented) An apparatus for displaying supplemental information particular to a user regarding displayed web pages for the user, the apparatus comprising:

means for identifying a particular product displayed in a first web page using a device that displays the first web page to the user and determining, with the device, whether an entry corresponding to the particular product displayed on the first web page is contained in a database on the device, wherein the database comprises supplemental information particular to a user and correlates the supplemental information to each of a plurality of products, and wherein the database is separate from the first web page and the first web page is ordinarily devoid of the supplemental information; and

means for displaying supplemental information correlated to the particular product along with and separate from the first web page if it is determined that the database contains an entry for the particular product.

30. (Previously Presented) The apparatus of claim 29, wherein the particular product is associated with a link to a second web page.

31. (Previously Presented) The apparatus of claim 30, wherein the second web page correlates to a purchasable item, and the supplemental information includes a consumer incentive available to the user and relating to the purchasable item, the consumer incentive being obtained from the database and not being ordinarily evident from the web page.

32. (Previously Presented) The apparatus of claim 31, wherein the consumer incentive is a discount for purchasing the purchasable item from the web site using a particular credit card, the database includes an entry indicating that the user has the particular credit card, and the supplemental information indicates that the user will obtain the consumer incentive where the particular credit card is used to purchase the purchasable item.

33. (Previously Presented) The apparatus of claim 29, further comprising:
means for detecting an event relating to the particular product, wherein the event prompts the display of supplemental information for the particular product.

34. (Previously Presented) The apparatus of claim 33, wherein the event is a cursor rollover of the particular product, and the supplemental information is superimposed on the first web page in the vicinity of the display of the particular product.

35. (Previously Presented) A computer readable storage medium that stores instructions for performing the steps of:

identifying a particular product displayed on a first web page in a first web page using a device that displays the first web page to the user;

determining, with the device, whether an entry corresponding to the particular product displayed on the first web page is contained in a database on the device, wherein the database comprises supplemental information particular to a user and correlates the supplemental information to each of a plurality of products, and wherein the database is separate from the first web page and the first web page is ordinarily devoid of the supplemental information; and

displaying supplemental information correlated to the particular product long with and separate from the first web page if it is determined that the database contains an entry for the particular product.

36. (Previously Presented) The computer readable storage medium of claim 35, wherein the particular product is associated with a link to a second web page.

37. (Previously Presented) The computer readable storage medium of claim 36, wherein the second web page correlates to a purchasable item, and the supplemental information includes a consumer incentive available to the user and relating to the purchasable item, the consumer incentive being obtained from the database and not being ordinarily evident from the web page.

38. (Previously Presented) The computer readable storage medium of claim 37, wherein the consumer incentive is a discount for purchasing the purchasable item from the web site using a particular credit card, the database includes an entry indicating that the user has the particular credit card, and the supplemental information indicates that the user will obtain the consumer incentive where the particular credit card is used to purchase the purchasable item.

39. (Previously Presented) The computer readable storage medium of claim 35, further comprising instructions for performing the step of:

detecting an event relating to the particular product, wherein the event prompts the display of supplemental information for the particular product.

40. (Previously Presented) The computer readable storage medium of claim 39, wherein the event is a cursor rollover of the particular product, and the supplemental information superimposed on the first web page in the vicinity of the display of the particular product.

EVIDENCE APPENDIX

NONE.

RELATED PROCEEDINGS APPENDIX

NONE.